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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,799	09/18/2003	Robert M. H. Dunn	CA920030059US1	9024

7590 06/14/2006

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EXAMINER

DAYE, CHELCIE L

ART UNIT PAPER NUMBER

2161

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/666,799	Applicant(s) DUNN ET AL.	
	Examiner Chelcie Daye	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/18/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to Application filed on September 18, 2003.
2. Claims 1-11 and 16-21 are pending. Claims 12-15 are withdrawn.
3. Claims 12-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse on May 25, 2006.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 16-21, drawn to a method for accessing data through query processing, classified in class 707, subclass 3.
- II. Claims 12-15, drawn to a system for generating a data structure via a user interface, classified in class 707, subclass 102.

Inventions I-VI are related as combination/subcombinations.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particular subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination (I) as claimed does not require the subcombination II as claimed because it is a method for accessing data through query processing, which does not require a system for generating a data structure via a user

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interface. The subcombination II, as claimed does not require combination I, as claimed because it is a system for generating a data structure via a user interface that need not be related to a method for accessing data through query processing. Therefore, the inventions are distinct; however, they could be usable together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for I is not required for II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Diana Roberts at (512) 823.9667 on May 25, 2006 requesting an oral election to the above restriction requirement, applicant elects Group I (claims 1-11 and 16-21) without traverse.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 9/18/2003 was filed on the mailing date of the application on 9/18/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

6. Figure 1 should be designated by a legend such as --Prior Art—because Fig. 1 was disclosed in the background of the specification and only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6,8,and 10 disclose ordered lists with specific formulas designated to represent the ordered lists. Examiner is unclear if there is any relevance to the arrangement of the formulas for each ordered list? Examiner is unclear if the variables are critical to the invention as a whole? Also, if the variables are critical to the invention, examiner is unsure of how and why?

Claim 10 language stated "and m is an integer representing the number of relationships in the storepath with the same asset type AT". However, the specification discloses " m is an integer representing the number of relationships in the storepath for relationship type RT". The support in the specification is not what has been claimed within the claim language. It is unclear to the examiner whether the "Sk1..." equation is the relationship type or the asset type and how one relates to the other.

Claims 7,9,and 11 disclose mapping functions, one of which is represented by MSP(), another represented as MSTRT(), and the last mapping function MSP(MATRT()), wherein the MSP encompasses the MATRT. Examiner is unclear if there is a distinction between the different mapping functions and if so, what are the distinct differences and how are they distinct from one another. Also, examiner is unclear if the mapping functions are distinct why they are called by the same name does this mean they are interchangeable with one another at any given time? Examiner

is also unclear how the variables are critical to the invention as a whole and exactly how and why the inventor derived the symbols for the variables?

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-21 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentability utility.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the present case, claims 19-21 recite a computer data signal embodied in a carrier wave and having means in the computer data signal for directing a data processing system. However, the data signal embodied in a carrier wave is considered non-statutory, because the carrier waves within the signal are merely an abstract idea, which is unable to be perceived by the senses, the statutory category therefore produces no concrete and tangible result.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (lack of utility) above are further rejected as set forth

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below in anticipation of applicant amending these claims to place them within the four statutory categories of invention with utility.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-11 and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker (US Patent No. 6,249,772) issued June 19, 2001.

Regarding Claims 1, 16, and 19, Walker discloses a method of accessing data regarding commerce assets such as products or services offered at virtual stores participating in a virtual marketplace in a client/server system based on a user query for data relating to a commerce asset for a particular asset type at a particular virtual store, the user accessing the client/server system through a client having a graphical user interface to obtain the user query and to display a response to the query, the assets data being stored in a database accessed by a resource manager, an application server interfacing the resource manager with graphical user interface, said method comprising the steps of:

a) establishing a storepath relationship correlating asset types among related stores (Figs. 6A and 6B; column 4-5, lines 65-67 and 1-12, Walker);

b) resolving the user query into at least a database query (column 16, lines 31-41, Walker) executable by the resource manager (column 9, lines 57-63, Walker);

c) retrieving assets data for asset type available at particular virtual store (columns 19 and 20, lines 58-67 and 1-5, respectively, Walker); and

d) returning assets data to user as the response to the query (column 20, lines 6-18, Walker).

Regarding Claims 2, 17, and 20, Walker discloses the method further comprising the step of:

e) storing storepaths relationships in memory (column 5, lines 35-41, Walker).

Regarding Claims 3, 18, and 21, Walker discloses the method wherein the step of resolving the user query into at least a database query executable by the resource manager further comprises constructing the database queries based on the storepaths relationships in the memory (column 5, lines 41-51, Walker).

Regarding Claim 4, Walker discloses the method wherein the each store SA has commerce assets CA having asset types AT (column 10, lines 24-34, Walker).

Regarding Claim 5, Walker discloses the method wherein each of the asset types AT is mapped into relationship type RT for each store SA (column 20, lines 19-35, Walker).

Regarding Claim 6, Walker discloses the method wherein the storepath for store SA and related stores SB_n for relationship types RT_n is determined based on an ordered list:

$$\{(SA, SB1, RT1, S1), (SA, SB2, RT2, S2), \dots, (SA, SBn, RTn, Sn)\}$$

where S is a value which may be used to sequence relationships with the same type, and $S1 \leq S2 \leq \dots \leq Sn$; and n is an integer representing the number of relationships in the storepath (column 19, lines 58-67, Walker).

Regarding Claim 7, Walker discloses the method wherein the storepath relationships for the stores are defined by a mapping function MSP() as:

$$MSP(SA, RT)(SB1, SB2, \dots, SBn) \text{ and}$$

the mapping function MSP() mapping the store SA and the relationship type RT to an ordered list of related stores (column 15, lines 45-59, Walker).

Regarding Claim 8, Walker discloses the method wherein the set of asset types AT for the storepath is represented by an ordered list:

$$\{(AT1, RT, SA), (AT2, RT, SA), \dots, (ATn, RT, SA)\} \text{ (column 9, lines 44-56, Walker).}$$

Regarding Claim 9, Walker discloses the method wherein a mapping function $\text{MATRT}(\)$ between the asset type AT and the relationship type RT is defined as:

$\text{MATRT}(\text{SA}, \text{AT})\text{RT}$ (column 14, lines 51-65, Walker).

Regarding Claim 10, Walker discloses the method wherein the list of commerce assets CA having the asset type AT for the store SA are defined by an ordered list:

$\{(\text{CA1}, \text{SBk1}, \text{Sk1}), (\text{CA2}, \text{SBk2}, \text{Sk2}), \dots, (\text{CAn}, \text{SBkn}, \text{Skm})\}$

where $\text{Sk1} \leq \text{Sk2} \leq \dots \leq \text{Skm}$; and m is an integer representing the number of relationships in the storepath with the same asset type AT (column 19, lines 31-46, Walker)

Regarding Claim 11, Walker discloses the method wherein the storepath relationship for the store SA and an asset type AT is defined by a composite mapping function $\text{MSP}(\)$ as follows:

$\text{MSP}(\text{SA}, \text{MATRT}(\text{SA}, \text{AT}))$ (columns 17-18, lines 52-67 and 1-18, Walker).

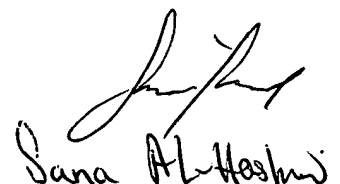
Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chelcie Daye whose telephone number is 571-272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chelcie Daye
Patent Examiner
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June 9, 2006


Sana Al-Hosni